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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,225	01/21/2004	Kia Silverbrook	WAL02US	1380

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,225

Applicant(s)

SILVERBROOK ET AL. 

Examiner

Daniel J. Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004 and 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-13 and 16-47 is/are rejected.
- 7) ☒ Claim(s) 4-8, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 32 of copending Application No.

10/760,214. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 32 of Application No. 10/760,214 includes all the structure recited in claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

3. Claims 19-34, 38 and 42-46 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 19-34, 38 and 42-46 are drawn to a

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media cartridge. However, these claims do not further limit the structure of the media cartridge but instead recites structure of the environment in which applicant intends to use the media cartridge. Since no language further limiting the media cartridge these claims fail to further the parent claim 1.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 35-37, 39-41 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 35-37, 39-41 and 47, the statutory class of invention being claimed is unclear. The preambles begin by reciting a “media cartridge as claimed in claim 1” which would suggest that the claim is directed towards an apparatus. But then the claims continue with the phrase, “adapted for use in a method. . .” and the body of each respective claim recites a series of method steps. This would suggest that applicant is attempting to recite a method claim.

For purposes of prior art examination, these claims will be interpreted as apparatus claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 13 and 16-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagel et al. (US 5,362,008).

With respect to claim 1, Nagel et al. discloses a media cartridge including a case having two halves 20a and 21 as shown in Figure 5 of Nagel et al. Further disclosed is a media supply slot 23 located between the two halves 20a and 21 when they are closed and a pair of rollers 39 and 40 inside the case and adjacent to the supply slot 23. Roller 40 is a driven roller which can be driven by an external motor and is supported at each end of the case as shown in Figure 5.

With respect to claim 3, Nagel et al. discloses fixture 41 at the end of the driven roller which is fixed to the shaft of the driven roller through an opening in the case.

With respect to claim 13, the driven roller 40, including the shaft of the roller is longer than the idler roller 39 as shown in Figure 5 of Nagel et al.

With respect to claims 16 and 17, Figure 5 shows that the roller 40, the driven roller, has shaft ends that pass through each side of case half 20a and connect to gears 41.

With respect to claim 18, Figure 5 shows that the media cartridge has a core inside media roll 35. The media on media roll 35 could be used as wallpaper.

With respect to claims 19-34, 38 and 42-46, applicant has not recited any language to further limit the media cartridge in these claims. Therefore, the claims are rejected along with their parent claim, claim 1.

With respect to claims 35-37, 39-41 and 47, applicant has not recited any language to further limit the structure of the media cartridge but instead has recited how applicant intends to

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use the media cartridge. Since no further structure of the media cartridge is recited these claims are rejected along with their parent claim, claim 1. See MPEP 2114.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagel et al. (US 5,362,008) in view of Yokota (US 4,690,344).

Nagel et al. discloses the claimed media cartridge except for the resilient bias of the two rollers. However, Yokota discloses a media cartridge including a case having two halves 4a and 5 hinged together at 19 so that a supply slot 15 is formed when the two halves are closed. Further disclosed by Yokota is a pair of internal rollers 6 and 7 of which the roller 7 is driven as shown in Figure 2A of Yokota. The roller 7 is biased towards the roller 6 by springs 21 as shown in Figures 2A and 2B of Yokota. It would have been obvious to combine the teaching of Yokota with the media cartridge disclosed by Nagel et al. for the advantage of allowing the roller 7 to feed different thicknesses of media.

10. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagel et al. (US 5,362,008) in view of Shiba (JP 10-291706).

With respect to claim 9, Nagel et al. discloses the claimed media cartridge except for the integral handle at one end of the case. However, Shiba teaches a media cartridge with a case formed from two halves 5 and 6 and a handle 4 located at one end as shown in Figure 3 of Shiba. It would have been obvious to combine the teaching of Shiba with the media cartridge disclosed by Nagel et al. for the advantage of providing a convenient location to grip the cartridge while inserting and removing from a machine that uses the cartridge.

With respect to claim 12, Shiba teaches that the media cartridge can be made of plastic (see paragraph 10 of the machine translation, last sentence), with an integral hinge 8 and a clip 10 for holding the two halves closed as shown in Figure 2 of Shiba. Note that “integral” can be broadly interpreted to mean “formed together as a unit.”

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagel et al. (US 5,362,008) in view of Inana et al. (US 2001/0006202).

Nagel et al. discloses the claimed media cartridge except for the folding handle. Nagel et al. discloses a handle 2 at the top of the case, but it does not fold. However, Inana et al. teaches a media cartridge with two case halves 3 and 4 with a folding handle 8 on the top surface of the case. It would have been obvious to combine the teaching of Inana et al. with the media cartridge disclosed by Nagel et al. for the advantage of a convenient gripping location for easily carrying the media cartridge that can also fold down to reduce the amount of space taken up by the cartridge.

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12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagel et al. (US 5,362,008) in view of Inana et al. (US 2001/0006202) as applied to claim 10 above, and further in view of Shiba (JP 10-291706).

Nagel et al. in view of Inana et al. discloses the claimed media cartridge except for the integral handle at one end of the case. However, Shiba teaches a media cartridge with a case formed from two halves 5 and 6 and a handle 4 located at one end as shown in Figure 3 of Shiba. It would have been obvious to combine the teaching of Shiba with the media cartridge disclosed by Nagel et al. in view of Inana et al. for the advantage of providing a convenient location to grip the cartridge while inserting and removing from a machine that uses the cartridge.

Allowable Subject Matter

13. Claims 4-8 and 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter:

Claims 4-8 and 14 have been indicated as containing allowable subject matter primarily for the pair of clips which engage slots of both rollers at one end.

Claim 15 has been indicated as containing allowable subject matter primarily for the internal slots for receiving a pair of clips which are used to hold the rollers in proximity.

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15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanaka, Murakami, Landis et al. and Satou et al. are cited to show other examples of media cartridges with an internal pair of rollers.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571)272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 6:00 pm. Faxes regarding this application can be sent to (703)872 - 9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571)272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 10, 2005


Daniel J. Colilla
Primary Examiner
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